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10/022,655	12/17/2001	Errol D'Souza	4665/8	1879

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EXAMINER

BELIVEAU, SCOTT E

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 08/27/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,655

Applicant(s)

D'SOUZA ET AL.

Examiner

Scott Beliveau

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other:

DETAILED ACTION

Specification

1. The attempt to incorporate subject matter into this application by reference to a provisional application is improper because the disclosure fails to clearly identify the application by serial number.
2. The disclosure is objected to because of a missing space in the term "software118" (Page 10, Line 9) and the term "Fig.3" (Page 13, Line 14). Appropriate correction is required.

Claim Objections

3. Claim 19 is objected to because the preamble sets forth a "system", but claims a "method". The examiner suggests that the phrase "the method comprising" be modified to reference "the system comprising". Appropriate correction is required.
4. Claim 21 is objected to because of a missing space in the phrase "claim 20wherein". Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2, 9-14, and 18-19 rejected under 35 U.S.C. 102(b) as being anticipated by Ohkura et al. (US Pat No. 5,737,029).

In consideration of claims 1, 18, and 19, the Ohkura et al. reference discloses a system and computer implemented method for “automatically flagging one or more tunable channels broadcast over a distribution network as a favorite channel” (Col 1, Lines 44-67; Col 2, Lines 22-32). As set forth in the flowchart of Figure 11, the embodiment is operable to “monitor commands input by the user” using an “input device” [5] (Col 5, Lines 4-9) including those “commands from the user to tune a channel” (Col 7, Line 63 – Col 8, Line 4), to “record an identifier for the channel” such as a channel number, and to inherently “increment a channel tune count indicator for the channel” in order to determine the most frequently received channel for a particular category and time band (Col 8, Lines 7-27). Subsequently, the embodiment “selects identifiers with the top indicators” for inclusion within the “list of automatic favorite channels” (Figure 14)

Claim 2 is rejected wherein the “list of automatic favorite channels” as illustrated in Figure 17 is associated with both the “identifier” or channel number as well as the “indicator” such that the channels are displayed in order of frequency (top to bottom) (Col 8, Line 49 – Col 9, Line 37).

Claim 9 is rejected wherein the embodiment is operable to “compare a duration that the channel is viewed for against a time threshold” such as 5 minutes wherein the identifier is only “recorded” if the “viewed for a duration greater than a time threshold” (Col 8, Lines 22-27).

Art Unit: 2614

Claim 10 is rejected wherein the user may “select” or utilize “a favorite control” [160] on the “input device” [50] in order to “traverse the list of automatic favorite channels” (Col 11, Lines 19-28).

Claim 11 is rejected wherein the “list of automatic favorite channels” (Figures 16-21) may be “traversed one channel for each time the favorite control is selected” (Figure 15; Col 10, Lines 24-46)

Claim 12 is rejected wherein the “list of automatic favorite channels” may be “traversed . . . in order according to a rank of the channels in the list of automatic favorites” using the up-down “favorite control” [160].

Claim 13 is rejected wherein Figures 16-21 of the embodiment “display an electronic program guide” that is “limited” to “programming available on channels” of the “retrieved . . . list of the automatic favorite channels.”

Claim 14 is rejected wherein the embodiment is operable to “receive” and “extract programming information” or “guide data” for “presentation within the electronic programming guide” (Col 5, Lines 9-19; Col 8, Lines 4-6).

7. Claims 1-7, 9-14, and 18-23 rejected under 35 U.S.C. 102(e) as being anticipated by Canelore et al. (US Pub No. 2002/0104081).

In consideration of claims 1, 18, and 19, the Candelore et al. embodiment discloses a system and computer implemented method (Page 4, Para. 41) for “automatically flagging one or more tunable channels broadcast over a distribution network as a favorite channel” (Page 1, Para. 18). As illustrated in Figure 5, the embodiment is operable to “monitor commands input by the user” from an “input device” [5] including “command from the user to tune a

Art Unit: 2614

channel” [402]. The embodiment subsequently “records an identifier for the channel” [406] and may “increment a channel tune count indicator for the channel” (Table 5; Page 3, Para 30; Page 5, Paras. 48-51). This information is utilized to “select identifiers with the top indicators” for inclusion within the “list of automatic favorite channels” (Page 4, Para. 47).

Claim 2 is rejected wherein the “list of automatic favorite channels” is associated in memory with both the “identifier” as well as the “indicator” (Page 3, Para. 32)

Claim 3 is rejected wherein the embodiment may “record the amount of time that the channel was viewed” (Tables 1-3) and use this information to “select identifiers with the top indicators and view times for inclusion within the list of automatic favorite channels” (Page 3, Para. 30; Page 4, Para. 45).

In consideration of claim 4, the reference discloses that the embodiment is operable to create the list of favorites [408] based on “comparing the identifier and indicator” to “determine if the indicator is greater than any indicator comprising the list”. The embodiment subsequently “adds the identifier and the indicator to the list” if it is “greater than any indicator comprising the list” (Page 4, Para. 47).

Claim 5 is rejected wherein the embodiment is operable to “remove from the list of automatic channels any identifier that falls below a view threshold value” so as to allow the list of favorites to change (Page 4, Para 46; Page 5, Para. 48)

Claim 6 is rejected wherein the “view threshold value” may be set to an “Nth highest indicator” (Page 4, Para. 38).

Claim 7 is rejected wherein the “view threshold value” may be a “user defined value” (Page 3, Para. 30).

Claim 20 is rejected wherein the aforementioned system [400] comprises a “channel list and view count data structure comprising a listing of channels viewed by a user and the number of times each channel has been tuned” [406]. The embodiment further comprises “favorite selection software” (Page 4, Para 41) to “record an identifier for a channel”, to “increment a channel tune count indicator for the channel”, and to further “select recorded identifiers with the top indicators for inclusion within a list of automatic favorite channels” [408] (Page 4, Paras. 44-47).

Claim 21 is rejected wherein the “data structure and software” are stored on a “memory” [404] of a set top terminal [2] connected to the “distribution network” [3].

Claim 22 is rejected wherein the “channel list and view count data” [406] and the “list of automatic favorite channels” [408] may be stored on separate memory devices (Page 3, Para. 32) including both DRAM and NVRAM (Page 2, Para 27).

Claim 23 is rejected wherein the “favorite selection software” may be stored on a “flash memory module” (Page 4, Para. 43; Page 5, Para. 57).

8. Claims 1, and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Florence et al. (US Pub No. 2002/0188948).

In consideration of claims 1, 18, and 19, the Florence reference discloses a system and computer implemented method or “automatically flagging one or more tunable channels broadcast over a distribution network as a favorite channel” (Page 1, Para. 21). As illustrated in Figure 5, the embodiment is operable to “monitor commands input by the user” from an “input device” [158] including “commands from the user to tune a channel” [520/530]. The embodiment subsequently “records an identifier for the channel” [403] and may “increment a

Art Unit: 2614

channel tune count indicator for the channel” [406] (Page 4, Para. 49 – Page 5, Para. 52).

This information is utilized to “select identifiers with the top indicators” [640] for inclusion within the “list of automatic favorite channels” [650] (Page 5, Para. 53-54).

Claim 20 is rejected wherein the aforementioned system [152a] comprises a “channel list and view count data structure comprising a listing of channels viewed by a user and the number of times each channel has been tuned” (Figures 4A-B). The embodiment further comprises “favorite selection software” [355] to “record an identifier for a channel”, to “increment a channel tune count indicator for the channel” and to further “select recorded identifiers with the top indicators for inclusion within a list of automatic favorite channels” [365].

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the

Art Unit: 2614

time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1, 13, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noguchi et al. (US Pat No. 6,034,677) in view of Candelore et al. (US Pub No. 2002/0104081).

In consideration of claim 1, the Noguchi et al. discloses a method and apparatus for displaying programming information in the form of an “electronic program guide” (Figure 13). Among its other features, the reference discloses that the guide may facilitate the user in designating certain programs as favorite programs. The reference, however, does not explicitly disclose nor preclude that this designation is a manual or automatic process or does it provide details pertaining to implementation of such an automated process.

The Candelore et al. embodiment discloses a method for “automatically flagging one or more tunable channels broadcast over a distribution network as a favorite channel” (Page 1, Para. 18). As illustrated in Figure 5, the embodiment is operable to “monitor commands input by the user” from an “input device” [5] including “command from the user to tune a channel” [402]. The embodiment subsequently “records an identifier for the channel” [406] and may “increment a channel tune count indicator for the channel” (Table 5; Page 5, Paras. 48-51). The embodiment utilizes this information to “select identifiers with the top indicators” for inclusion within the “list of automatic favorite channels” (Page 4, Para. 47).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Noguchi et al. favorite channel designation method to utilize the automatic flagging favorite channel teachings of Candelore et al. for the purpose

Art Unit: 2614

of presenting the viewer with a selection of favorites based on a number of criteria without having to program manually the list of favorites (Candelore et al.: Page 1, Para. 18).

In consideration of claim 13, the reference suggests that the Candelore et al. embodiment is operable to “display an electronic program guide” and to “retrieve the list of automatic favorite channels” (Page 2, Para. 20). The reference, however, does not explicitly disclose that the information is necessarily “limited” in scope to “presenting the programming available on channels comprising the list of automatic channels”. As illustrated in Figure 20, the Noguchi et al. reference discloses that it is operable to “limit the scope of information presented by the program guide to programming available on channels” that is associated with a particular categorization. Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Noguchi et al. reference to include a “Favorites” category for the purpose of facilitating the finding and selection of programming associated with favorite channels (Candelore et al. Page 1, Para. 3).

In consideration of claim 15, as illustrated in Figure 13, the program guide comprises a “full screen program guide comprising listings of programs available on the distribution network” (Noguchi et al.: Col 9, Lines 6-18).

Claim 16 is rejected wherein as illustrated in Figures 10-13, the full screen program guide [1301] comprises “audio and video associated with the channel viewed before the guide is displayed” (Noguchi et al.: Col 8, Line 25 – Col 9, Line 8).

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US Pub No. 2002/0104081).

In consideration of claim 8, the Candelore et al. reference, while disclosing that a user may set a threshold value (Page 3, Para. 30) does not explicitly disclose or preclude “setting the view threshold value to a value set dynamically by a content service provider”. It would have been an obvious matter of design choice for the content provider to dynamically set the view threshold value, since the application has not disclosed that the use of such solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with a threshold supplied by the user.

Assuming arguendo, the Candelore et al. reference discloses that the CPU [29] executes software based instructions to create automatically a list of favorites (Page 4, Para. 41) and that the CPU [29] may program user settings/preferences for the broadcast system [100] (Page 2, Para 27). The examiner takes OFFICIAL NOTICE that it is notoriously well known in the art for a service provider to periodically distribute software to set top terminal units in order to update operating parameters. Accordingly, it would have been obvious to one having ordinary skill in the art to modify the Candelore et al. embodiment to “set the view threshold value to a value set dynamically by a content service provider” for the purpose of providing a flexible means by which the content service provider may customize the operation of the set top terminals.

13. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US Pub No. 2002/0104081) in view of McClard (US Pat No. 6,438,752).

In consideration of claim 17, the reference discloses a scenario wherein the embodiment is operable to “determine a time of day and a day of the week” and “based upon the date and time” select the “identifier” with the top indicator (Page 5, Para. 55). The embodiment is

Art Unit: 2614

operable to “select identifiers with the top indicators for inclusion within a list of automatic favorite channels” based on one or more items according to user preferences (Page 2, Para. 28; Page 3, Para. 30). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the embodiment, if necessary, to provide an automatic list [408] using two or more identifiers such as “time of day and a day of the week” for the purpose of advantageously assisting the user in selecting favorite programming options that are relevant to current time period. For example, while it might be interesting to learn that “Green Acres” is a favorite program, the information is not particularly helpful/useful if the program is not currently being aired.

Assuming arguendo, the McClard reference explicitly discloses a method to “select identifiers with the top indicators for inclusion within a time specific list of automatic favorite channels” (Col 6, 6, Lines 16-61). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Candelore et al. reference, if necessary, so as to generate a “time specific list of automatic favorite channels” as taught by McClard for the purpose of providing a system which allows each individual user to quickly and easily browse through programs of particular interest regardless of the time of day or week (McClard: Col 2, Lines 4-7).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of

Art Unit: 2614

claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.


- The Soundararajan (US Pub No. 2003/0084448) reference discloses a system and method for automatically building, updating and using television channel selection lists for enhanced television control wherein the embodiment generates up-to-date viewer-preference lists to control the channel-selection process.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 8:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

SEB
August 18, 2003


JOHN MILLER
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